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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,285	08/20/2001	William E. Smith III	8930	5719

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PAUL W. MARTIN
NCR CORPORATION, LAW DEPT.
1700 S. PATTERSON BLVD.
DAYTON, OH 45479-0001

EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/933,285	Applicant(s) SMITH ET AL.	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Amendment***

1. The amendment filed 12/19/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In independent method claim 1, lines 4-6, "and extracted from a knowledge management system ... into solution deliverables", claims 15-16 (part of 1) and independent method claims 11 and 12.

The examiner has scanned through the specification but could not find support for these amended language. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In claim 1, lines 4-5, "extracted from and extracted from ... into solution deliverables" are vague.

2) Claim 1, recites the limitation "the submission" in step (c). There is insufficient antecedent basis for this limitation in the claim.

3) In claim 1, it's not clear the relationship step (c.), "members of the organization" to the subsequent steps (d), (e), and (f). Step (e) using the

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“screened ideas” of step (d). So, it’s not clear what happens to the “stored ideas” being displayed to the members of the organization?

4) In claim 1, step (f) is not clear. What is or who is entering?

5) It’s not clear how dep. claim 7 further limits step (b) of claim 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-10 are rejected under 35 U.S.C. 103(a) as obvious over GAKIDIS et al (US 2002/0095305).**

As for independent method¹ claim 1, GAKIDIS et al discloses a method and system for managing the submission of ideas in an organization, comprising the following steps:

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- (a) collecting the ideas (information/data) extracted from a plurality of sources including ideas submitted through an idea submission tool {see [0020, 26, 0042], Fig.1};
- (b) storing the data into an electronic archive (database) accessible through a network {see [0042, 0048, 0026], Fig. 1};
- (c) displaying the ideas to members of organization so that the members of the organization can provide additional thoughts to the submission {see [0019, 0058, 0072, 0026]};
- (d) providing the ideas to a management screening committee for screening {see 0019, 0024, 0026},
- (e) submitting ideas screening by the management screening committee to an idea sponsor (or supporter or *"experts who have agreed to participate in supporting, and thus effectively sponsor, the idea"*) {[0058, 0048, 0056]}; and
- (f) entering into an opportunity screening phase (*"presenting to the financier"*) {[0058, 0059, 0021]}.

Note that in (a) the sources of the collected ideas, i.e. "ideas extracted from" have minimum or no patentable weight since they do not clearly define what are the features of the ideas, i.e. ideas containing data about work issues, etc. it's irrelevant where the sources of the ideas come from as long as the ideas are the same. Data or ideas is defined by what it's made up or what it is and not by where it comes from. If the "extraction" limitation is critical, the rewriting of the

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claim to include active step of "extracting the ideas from, collecting the extracted ideas" is recommended to improve clarity and patentable weight.

As for dep. claim 2 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. selection someone, group, committee or department to collect submitted ideas, this is taught in [0005, 0010 or 0011]. As for the name of the committee, the selection of any name is a matter of choice and would have been obvious to a skilled artisan as mere non-essential modifications within the scope of the claim as discussed by GAKIDIS et al on [0119].

As for dep. claim 3 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. using e-mail for communication on the Internet/web, this is well known and inherently included in GAKIDIS et al. Alternatively, it would have been obvious to a skilled artisan to communicate using e-mail since this is well known communication mean on the Internet/Web.

As for dep. claim 4 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. convening a meeting when the submission volume reaches a certain level, this is inherently included in the teachings of GAKIDIS et al or would have been obvious to a skilled artisan as mere routine experimentations in view of the teachings on [0119].

As for dep. claims 5-6 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. including exploratory and development of ideas, this is taught in [0003-0008].

As for dep. claim 7 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. entering ideas into a web-based archive interface, this is taught in Fig. 1, [0072, 0072].

As for dep. claim 8 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. displaying the ideas on the website to other viewers, including submitter, this is inherently included in Fig. 1, [0020] of GAKIDIS et al.

As for dep. claim 9 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. the type or features of the reviewers, experienced reviewers, this is taught in [0010 "senior managers", 0019 "Experts", 0049].

As for dep. claim 10 (part of 1 above), which deals with well known ideas submission/reviewing parameters, i.e. general evaluation/feedback communication, this is taught in [0054, 0055, 0058, Fig. 2].

6. Claims 12-14, and 11 are rejected under 35 U.S.C. 103(a) as obvious over GAKIDIS et al (US 2002/0095305).

As for independent apparatus¹ claim 12, which is the apparatus to carry out the method of claim 1 above, it's rejected over the computer network system of GAKIDIS et al to carry out the method of claim 1 above. As for the limitation of the archive being searchable by keyword, Official notice is taken that search service by key word, after e-mail, are frequent used tools on the Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost. It would have been obvious to a

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skilled artisan to include search service by key word for the benefit cited above which is Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost.

As for dep. claims 13-14 (part of 12), which deal with well known screen displaying parameters for receiving inputs from idea submitter, input boxes, and variety of functional boxes in the input boxes, these are inherently included in the system of GAKIDIS et al, see Fig. 1.

As for independent method² claim 11, which has nearly the same scope and steps as in claims 1, 2, 3, and 10, it's rejected for the same reasons set forth in claims 1, 2, 3, and 10 above. Moreover, these limitations are fairly taught in GAKIDIS as indicated above.

7. Claims 12-14 are rejected (2nd) under 35 U.S.C. 103(a) as obvious over GAKIDIS et al (US 2002/0095305) in view of DAVIS et al (US 2001/0047354) or PETRAS et al (US 2001/0047290).

As for independent apparatus¹ claim 12, the teachings of GAKIDIS et al is cited above.

DAVIS et al is cited to teach that search service by key word, after e-mail, are frequent used tools on the Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost {see [0008, 0009, 0010]}. It would have been obvious to a skilled artisan to modify GAKIDIS et al by including search service by key word as taught by

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DAVIS et al for the benefit cited above which is Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost.

PETRAS et al al is cited to teach that search service by key word, after e-mail, are frequent used tools on the Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost {see [0038, Figs. 15, 20]}. It would have been obvious to a skilled artisan to modify GAKIDIS et al by including search service by key word as taught by PETRAS et al for the benefit cited above which is Internet for exchanging and finding relevant information that could lead to marketing or potential business transaction at low cost.

As for dep. claims 13-14 (part of 12), which deal with well known screen displaying parameters for receiving inputs from idea submitter, input boxes, and variety of functional boxes in the input boxes, these are inherently included in the system of GAKIDIS et al, see Fig. 1.

Response to Arguments

8. Applicant's main arguments (2) filed 12/19/2005 have been fully considered but they are not persuasive.

1) Applicant's comment that GAKIDIS et al fails to teach the limitations of the amended language is noted, however, it's not found persuasive in view of the objection of new matter in paragraph no. 1 and the 103 rejections of claim 1 as shown in paragraph no. 5 above.

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2) Applicant's comment that GAKIDIS et al fails to teach the limitations of step (f) in claim 1 is noted, however, it's not found persuasive in view of paragraph no. 5 above.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

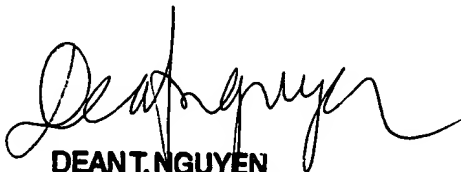
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
April 1, 2006


DEAN T. NGUYEN
PRIMARY EXAMINER